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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,029	08/27/2003	Jeffrey M. Ondra	DEP5108USA	6457
27777 7590 08/01/2008 PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003				
EXAMINER				
BLANCO, JAVIER G				
ART UNIT		PAPER NUMBER		
3774				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/650,029

**Applicant(s)**

ONDRLA ET AL.

**Examiner**

JAVIER G. BLANCO

**Art Unit**

3774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,5-9,11,12,15-17,19,21-24 and 27-31, and 41 is/are pending in the application.
- 4a) Of the above claim(s) 41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-9,11,12,15-17,19,21-24 and 27-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsman's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 27, 2008 has been entered.

### ***Response to Amendment***

2. Applicants' amendment of claims 1, 11, and 21 in the reply filed on May 27, 2008 is acknowledged.

3. Applicants' cancellation of claims 4, 14, and 26 in the reply filed on May 27, 2008 is acknowledged. Although the status identifier of said claims is: (cancelled), the text of said claim is still available. This does not comply with 37 CFR 1.121.

### ***Claim Objections***

4. Claim 22 is objected to because of the following informality: please substitute "said trail" (see line 2) with --said ~~trail~~ trial-. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 5, 6-9, 11, 12, 15-17, 19, 21-24, 27-29, and 31 are rejected under 35

U.S.C. 102(b) as being clearly anticipated by **Siebrandt** (US 2,181,746).

Referring to Figures 1-5, Siebrandt discloses a positioning fixture *for positioning* at least one of a trial and a prosthesis in the medullary canal of a long bone, said fixture comprising: a body (12/14); a first member (pin 27) member *for cooperation* with the body, said member extending from said body and *adapted to extend* through at least a portion of the long bone (see Figures 2 and 5) and into the medullary canal; second (20) and third (29) members (which are spaced a distance from the first member), any of said members *adapted to support* (capable of supporting) at least one of the trial and the prosthesis as the one of the trial and the prosthesis is positioned with respect to the long bone (see page 2, second column, lines 67-75); and a securing feature (15) cooperable with said body (12/14); said body comprising a crescent-shaped member (clearly visible in Figure 4, when clamp is open) *for at least partially surrounding* the long bone (see Figures 2 and 5), the crescent-shaped member comprising a first portion (12) and a second portion (14) moveably attached (16) to said first portion, the first portion and the second portion both being shaped so as to create a crescent. Regarding dependent claim 2, no structure is offered therein since the entire claim only offers a functional limitation. Any of the members disclosed above is capable of permitting relative relative motion between the body and the one of least one of the trial and the prosthesis (the trial and prosthesis are not positively claimed in independent claims 1 and 11) as the one of the trial and the prosthesis cooperates with said member. The “securing feature” could be the inner/inside wall of the body, which frictionally engages (“for

securing”) the fixture to the long bone. If a person skilled in the art continues turning (e.g., screwing) a pin or screw into a bone it will eventually be adapted to extend through the cortical bone and into the medullary canal.

Regarding independent claim 21, the structure of the “trial” (one of the options offered by “one of a trial and a prosthesis”) has not been disclosed. Siebrandt discloses a “trial” (e.g., wire, suture; further drill bits, etc.) at page 2, second column, lines 67-75. The “cooperation feature” is the outside/external periphery of the “trial”. Further, structure 28 can also be broadly interpreted as the “trial”, which comprises a “cooperation feature” (26) slidably receiving a “first member” (27).

With regards to statements of intended use and other functional statements (e.g., *for positioning; adapted to extend; adapted to support; for at least partially surrounding; adapted to permit*; etc.), they do not impose any structural limitations on the claims distinguishable over the device of **Siebrandt**, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969).

7. Claims 1, 2, 5-9, 11, 12, 15-17, 19, 21-24, and 27-31 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Maroney et al.** (US 6,277,123 B1).

Referring to Figures 1-7, Maroney et al. disclose a positioning fixture (clamp 20, or clamps 20/50) *for positioning* at least one of a trial and a prosthesis in the medullary canal of a long bone (see Abstract), said fixture comprising: a body (**first interpretation:** a pair of jaws 21; **second interpretation:** central portion 11); a first member (pin 17) member *for cooperation* with the body, said member extending from said body and *adapted to extend* through at least a portion of the long bone and into the medullary canal (**first interpretation:** along the medullary canal and into, or through, the bone; **second interpretation:** *if* a bore is created transversely through the cortical bone, pin 17 will be adapted to extend through at least a portion of the long bone; **third interpretation:** if a person skilled in the art continues turning (e.g., screwing) a pin or screw into a bone it will eventually be adapted to extend through the cortical bone and into the medullary canal); second and third members (22, 40, 52, and/or 54) which are spaced a distance from the first member, any of said members *adapted to support* (capable of supporting, directly or indirectly) at least one of the trial and the prosthesis as the one of the trial and the prosthesis is positioned with respect to the long bone (see Figures 1-5); and a securing feature (e.g., serrations in jaws 21) cooperable with said body; said body comprising a crescent-shaped member (clearly visible in Figures 1a, 5, and 6) *for at least partially surrounding* the long bone (see Figures 1-5), the crescent-shaped member comprising a first portion (**first interpretation:** a jaw 21; **second interpretation:** upper arms 12) and a second portion (**first interpretation:** the other jaw 21; **second interpretation:** lower arms 12) moveably attached (clearly visible in Figures 1a, 5, and 6) to said first portion, the first portion and the second portion both being shaped so as to create a

crescent. Regarding dependent claim 2, no structure is offered therein since the entire claim only offers a functional limitation. Any of the members disclosed above is capable of permitting relative relative motion between the body and the one of least one of the trial and the prosthesis (the trial and prosthesis are not positively claimed in independent claims 1 and 11) as the one of the trial and the prosthesis cooperates with said member (further shown in Figures 1-5). Regarding the "cooperation feature" it is either the outside/external periphery of the "trial" and/or prosthesis, OR holes 65 (as shown in Figure 7) slidably receiving pins of 52, 54. The "securing feature" could be the inner/inside wall of the body, which frictionally engages ("for securing") the fixture to the long bone.

With regards to statements of intended use and other functional statements (e.g., *for positioning; adapted to extend; adapted to support; for at least partially surrounding; adapted to permit; etc.*), they do not impose any structural limitations on the claims distinguishable over the device of **Maroney et al.**, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA1959). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969).

8. Claims 1, 2, 5-9, 11, 12, 15-17, 19, 21-24, and 28-31 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Kenyon et al.** (US 5,342,362 A).

Referring to Figures 1-4, 7, 10, and 11, Kenjon et al. disclose a positioning fixture (adaptor 30 and/or indicator 110) *for positioning* at least one of a trial and a prosthesis in the medullary canal of a long bone, said fixture comprising:

- a. A body (**Figures 7, 10 and 11**: assembly comprising clamp 124); and
- b. Members (**Figures 7, 10 and 11**: anchor pin 96) *for cooperation* with the body.

As shown in Figures 7, 10, and 11, the body comprising a crescent-shaped member (e.g., clamp 124) and is capable of at least partially surrounding the long bone. Said member extending from said body and *adapted to extend* through at least a portion of the long bone and into the medullary canal, said member *adapted to support* at least one of the trial (see Figure 10) and the prosthesis (see Figure 11) as the one of the trial and the prosthesis is positioned with respect to the long bone. Said one of said trial and said prosthesis including a cooperation feature (**Figures 7, 10 and 11**: transversal grooves and/or longitudinal grooves on stem 6, 100). As shown in Figures 7, 10, and 11, the “first portion” is one end (or one half) of the body, and the “second portion” is the other end (or other half) of the body, wherein one end/half is “movably attached” to the other end/half (**first interpretation**: “if one portion moves, the other portion moves as well”; **second interpretation**: there is a natural hinge in the middle of the crescent, in between both portions; **third interpretation**: portions are “movably attached” at ends connected by wing nut). Also, housing 32 comprises leg 35 and arm 36 (see Figures 1-3). The “securing feature” could be the inner/inside wall (or an external portion or surface) of the body, which frictionally



engages (“for securing”) the fixture to the long bone. Also, the “securing feature” could be nipples 48 and/or arms 44,46 (Figures 1-3) or connection port 116 (Figures 7, 10, and 11).

With regards to statements of intended use and other functional statements (e.g., *for positioning; adapted to extend; adapted to support; for at least partially surrounding; adapted to permit; etc.*), they do not impose any structural limitations on the claims distinguishable over the device of **Kenyon et al.**, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969).

### ***Response to Arguments***

9. With regards to the 102(b) rejection based on **Kenyon et al.** (US 5,342,362 A), Applicants’ arguments filed May 27, 2008 have been fully considered but they are not persuasive.

a. The Applicants argue Kenyon et al. ‘362 do not disclose “*the crescent-shaped member comprising a first portion and a second portion moveably attached to said first portion, the first portion and the second portion both being shaped so as to create a crescent*”. The Examiner respectfully disagrees. As shown in Figures 7, 10, and 11, the “first portion” is one end (or one

half) of the body, and the “second portion” is the other end (or other half) of the body, wherein one end/half is “movably attached” to the other end/half (**first interpretation:** “if one portion moves, the other portion moves as well”; **second interpretation:** there is a natural hinge in the middle of the crescent, in between both portions; **third interpretation:** portions are “movably attached” at ends connected by wing nut).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javier G. Blanco whose telephone number is 571-272-4747. The examiner can normally be reached on M-F (9:00 a.m.-7:00 p.m.), first Friday of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, David Isabella can be reached on **(571)272-4749**. The fax phone numbers for the organization where this application or proceeding is assigned is 571-273-8300 for regular communications and After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 3738

/Javier G. Blanco/

Examiner, Art Unit 3774

/Dave Willse/

Primary Examiner, Art Unit 3738